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EXAMINER
WINTER, JOHN M

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>13 July 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 11-18* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

The Applicants amendment filed on July 13,2007 is acknowledged, Claims 1-9 and 11-

18 remain pending .

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim1 is rejected under35 U.S.C. 112, second paragraph, as being incomplete for

omitting essential steps, such omission amounting to a gap between the steps. See MPEP

§ 2172.01. The omitted steps are: means for creating a state machine representative of said

contract or agreement, at least some terms of said contract or agreement being represented as a

state variable of said state machine," Examiner states that this claim fails to meet the requirement

for "means for" language as stated in 35 U.S.C. 112, sixth paragraph

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. This claim contains the term "wishes or intentions", Examiner notes that a "wish" is

indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9 and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US Patent 6,148,290) in view of Student Edition Restatement of the Law Second Contracts 2d (Contracts 2d)

As per claim 1,

Dan discloses apparatus for determining a right or obligation of a contract or agreement at any point in time,

comprising means for creating a state machine, at least some terms being represented as a state variable of said state machine; means for storing said state machine, the state machine having a status, means for:

causing the state machine to receive data representative of performance of at least one of the parties of one or more events relevant to the contract or agreement, (Column 3, lines 32 – Column 4, line 30; Figure 8)

determining whether said event changes the status of said state machine, (column 7, lines 47-60)

changing the status of said state machine if required by the determination, (Column 3, lines 32 – Column 4, line 30)

determining the right or obligation in response to the received data and the status of the state machine. (Column 3, lines 32 – Column 4, line 30)

Dan does not explicitly disclose representative of said contract or agreement, . Contracts 2d ('327) discloses representative of said contract or agreement, (Pages 5-8, A contract Defined). It

would be obvious to one having ordinary skill in the art at the time the invention was made to

combine the Dan method with the Contracts 2d method in order to allow representation of a

contact as a finite state automaton; furthermore the combination of these elements does not alter

their respective functions, and the combination would have yielded predictable results to one of

ordinary skill in the art at the time of the invention..

Claims 9 and 11-14 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 2.

Dan et al. discloses apparatus according to claim 1,

comprising means for storing a plurality of state machines, each representative of a

respective contract or agreement, the right or obligation of each said contract or agreement being

determinable concurrently as required. (Column 3, lines 32 – Column 4, line 30)

As per claim 3,

Dan et al. discloses apparatus according to claim 1,

wherein a computer language for realizing the apparatus is an object-orientated computer

language, such that the right or obligation of a contract state machine object includes assertions

that the object makes to other objects or systems. (Column 3, lines 32 – Column 4, line 30

[Examiner notes this claim is directed towards the intended usage of an apparatus])

As per claim 4,

Dan et al. discloses apparatus according to claim 1, including software components or systems for:

(a) receiving the right or obligation assertions of a virtual contract,

and (b) determining and implementing the "wishes" or "intentions" of the contracts, as required. (Column 3, lines 32 – Column 4, line 30)

As per claim 5,

Dan et al. discloses apparatus according to claim 1,

comprising a kernel including means for storing a plurality of contract or agreements as state machines, means for receiving information regarding events relevant to one or more of the contracts or agreements, and means for changing the state of one or more of the state machines as required according to said event.(Column 5 line 64 – column 6, line 10 [Examiner notes that a "kernel" is an inherent part of any OS, any computer with an OS would have a kernel])

As per claim 6,

Dan et al. discloses apparatus according to claim 5,

comprising an event queue for accommodating "external" and "internal" events. (Figure 5)

As per claim 7,

Dan et al. discloses apparatus according to claim 1,

wherein if the state of a contract or agreement is not changed for a predetermined period of time, the means for storing is arranged so the contract is persisted in the storage means, to await an the occurrence of one or more events which affect its behaviour or output. (Column 3, lines 32 – Column 4, line 30)

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: ."Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

As per claim 8,

Dan et al. discloses apparatus according to claim 1,

further including a virtual contract manager arranged so that upon initialization, virtual contracts are registered with the virtual contract manager such that the virtual contracts can subscribe to events that affect their behaviour to the right or obligation at any given time. (Column 3, lines 32 – Column 4, line 30)

As per claim 15,

Dan et al. discloses apparatus according to claim 1,

wherein the status is determined by the state variable. (Column 3, lines 32 – Column 4,

line 30)

As per claim 16,

Dan et al. discloses apparatus according to claim 1,

wherein the contract or agreement is in force. (Column 3, lines 32 – Column 4, line 30)

As per claim 17,

Dan et al. discloses the method of claim 9,

wherein the status is determined by the state variable. (Column 3, lines 32 – Column 4,

line 30)

As per claim 18

Dan et al. discloses the method of claim 9, wherein the contract or agreement

is in force. (Column 3, lines 32 – Column 4, line 30)
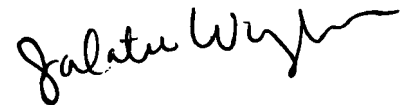

Response to Arguments

The Applicant's arguments filed on July 13, 2007 have been fully considered. The

amended claims are rejected are rejected as being unpatentable over Dan et al. (US Patent

6,148,290) in view of Student Edition Restatement of the Law Second Contracts 2d (Contracts

2d)

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

JALATEE WORJLOH
PRIMARY EXAMINER

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter

Patent Examiner -- 3621